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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/232,212 | 01/19/1999 | JEFFREY ALLEN JONES | AT9-98-567 | 2081 |

35525 7590 12/11/2003

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| EXAMINER |
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WON, YOUNG N

| ART UNIT | PAPER NUMBER |
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2155

DATE MAILED: 12/11/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/232,212

Applicant(s)

JONES ET AL

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 have been cancelled.
2. Claims 21-25 and new claims 26-38 have been examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 21-25, 27-31, and 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Rowley (US 5999740 A).

Independent:

As per claims 21, 27, and 33, Rowley teaches a method, an apparatus, and a computer program product in a computer-readable medium for communicating over Internet comprising: responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted (see col.1, lines 30-37); generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission (see Fig.9); and responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection (see col.5, lines 59-61).

Dependent:

As per claims 22, 28, and 34, Rowley further teaches wherein the message includes a selection control for each information element disclosed in the message (see Fig.9 and col.5, lines 35-53).

As per claims 23, 29, and 35, Rowley further teaches wherein each selection control is selected by default (see col.5, lines 54-57).

As per claims 24, 25, 30, 31, 36, and 37, Rowley teach of further comprising: responsive to deselection of a selection control, blocking transmission of the information element corresponding to the selection or deselection control (see Fig.9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26, 32, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowley (US 5999740 A) in view of Reha et al. (US 6282709 B1). Rowley teaches all the limitations of claims 26, 32, and 38 except wherein the message presents the address of the Internet server to which the information is to be transmitted. Reha teaches wherein the message presents the address of the Internet server to which the information is to be transmitted (see col.10, lines 63-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Reha within the system of Rowley by presenting the Internet server address to which the information is to be transmitted within the Internet communicating method, apparatus, and program because this would provide the user with additional information and allow the user to have additional control to continue or cancel the update transmission.

Response to Arguments

5. In response to the argument regarding the teachings of Rowley, Rowley clearly teaches the limitation of "generating a message..." and "cancel control for canceling

transmission... of the information over the established Internet connection" (see references provided). It is noted that the transmission of "to" and "from" is not explicitly mention, but rather "communicating over Internet". Additionally, one of ordinary skill in the art would question which specific device is an "Internet processor", and concur that any device able to transmit and receive data, via the Internet, which includes a processor is an Internet processor. Therefore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

With the cancellation of claims 1-20, the examiner found no need to include the Turek reference to teach additional elements, thus to clarify the prosecution of this application, this application remains non-final with this action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

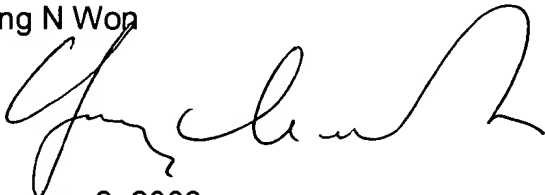
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 09/232,212
Art Unit: 2155

Page 6

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



December 9, 2003



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER